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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/677,657
Filing Date: October 02, 2003
Appellant(s): MARTINEZ, ANTHONY EDWARD

Robert V. Wilder
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 07, 2008 appealing from the Final Office action mailed July 07, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

In summary, the corrections as they appear are as follows:

Claims 1, 3-5, 8-11, 13-15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* (U.S. Pat No. 6,891,551).

Claims 2 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Keely et al.* (U.S. Pat No. 6,891,551) in view of *Carroll et al.* (US PGPUB 2003/0103082 A1).

Claims 6 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Keely et al.* (U.S. Pat No. 6,891,551) in view of *Nakayama et al.* (US 5,737,618 A).

In the Final Office Action (Mail Dated: 7/27/2007), from which Appellants appeal, a typographical error appeared in the 10th numbered paragraph. In that paragraph, the heading read:

10. **Claims 1-6, 8-16 and 18-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* (U.S. Pat. No. 6,891,551 B2).

However, claims 2, 6, 12 and 16 should not have been listed in the above sentence because they were exclusively treated in other paragraphs of that same Action. More specifically, claims 2 and 6 were analyzed exclusively under paragraph 11, while claims 12 and 16 were analyzed exclusively under paragraph 12.¹ For that reason paragraph 10 should have read:

10. **Claims 1, 3-5, 8-11, 13-15, and 17-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* (U.S. Pat. No. 6,891,551 B2).

¹ Paragraph 11 of the Final Office Action from which Appellant appeals, reads: "11. **Claims 2 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* in view of *Carroll et al.* (US PGPUB 2003/0103082 A1)." Paragraph 12 of the Final Office Action from which Appellant appeals, reads: "12. **Claims 6 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* in view of *Nakayama et al.* (US 5,737,618 A).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the Brief is correct.

(8) Evidence Relied Upon

U.S. Patent No. 6,891,551 B2	<i>Keely et al.</i>	May 10, 2005
U.S. Patent No. 5,737,618 A	<i>Nakayama et al.</i>	April 7, 1998
U.S. Pg-Pub. No. 2003/0103082 A1	<i>Carroll et al.</i>	June 5, 2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

CLAIM REJECTIONS - 35 U.S.C. §103

1. The following is a quotation of 35 U.S.C. 103(a) which formed the basis for all obviousness rejections set forth the Final Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The Scope of the Prior Art and Level of Ordinary Skill²

Keely et al. teach a computer system and method for highlighting and selecting elements of electronic documents is disclosed. In one embodiment, *Keely et al.* make known a selection area that identifies an initial selection of data, where

² "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6)

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one or more selection handles appear on the selection area to allow dynamic resizing of that selection area to select a larger or smaller portion of data or number of items. (*Keely et al.*, Abstract). They further suggest that a portion of the selection tool used to indicate which text is selected be "...translucent or transparent to allow reading of selected/highlighted text." (col. 5, lines 30-42). For convenience, the Examiner has reproduced figure 6B of *Keely et al.* below:

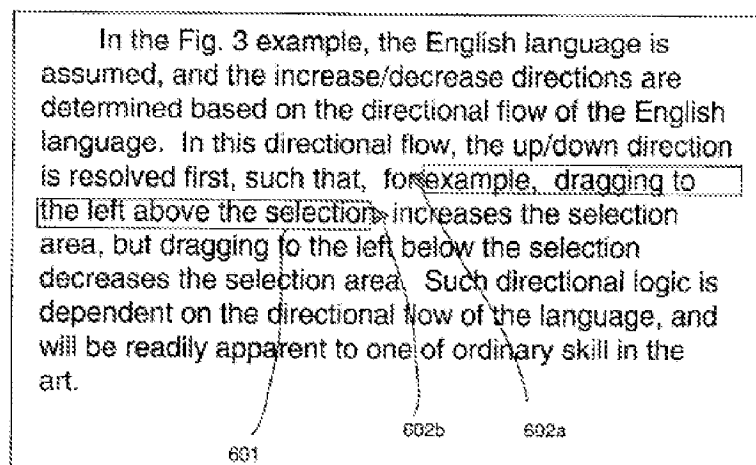


FIG. 6B

Accordingly, with reference to figure 6B, the Examiner finds that *Keely et al.* teach the making portions of the selection tool translucent or transparent for the purpose of allowing a user to read the selected or highlighted text.

While *Keely et al.* show selection handles 602a and 602b, as illustrated in figure 6B above, with shading that is darker than the rest of body 601, if one refers to figure 3, they would see the entire tool being depicted using a translucent or

transparent. It appears that when *Keely et al.* address the problem of being able to see the underlying text through their tool (e.g., col. 5, lines 30-42), they instead illustrate both selection handles 302a and 302b the same way as the translucent/transparent body 301:

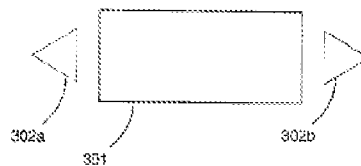


FIG. 3

Accordingly, with reference to figure 3, the Examiner finds that *Keely et al.* suggest making the entire selection tool translucent or transparent for the purpose of allowing a user to read the selected or highlighted text.

Carroll et al. teach selecting regions in an electronic text to edit selected regions on a continuous basis, without destroying the original highlighting and forcing the user to re-bracket the entire section. *Carroll et al.* teach that this economizes on keystrokes and cursor actions, since the whole region of text desired to be highlighted does not have to be rebuilt every time a change is made. *Carroll et al.*'s tool also enables a user to select text by moving a cursor from left to right and top to bottom, and to deselect text by moving a cursor from right to left and bottom to top. (Abstract, *Carroll et al.*). *Carroll et al.* disclose that: "[t]he positional indicator, preferably a cursor 104, is positioned at the edge of the selected region

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106." (Para. [0025]). To illustrate, the Examiner will reproduce figure 3 of *Carroll et al.* below:

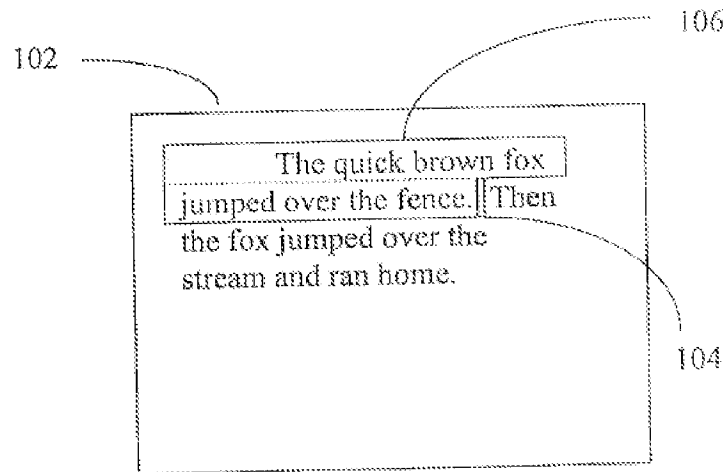


Fig. 3

Accordingly, with reference to figure 3, the Examiner finds that *Carroll et al.* teach the use of a rectangular block for an endpoint marker of an adjustable text selection tool.

Nakayama et al. teach, in a document processing system, performing a function of storing in a memory data of a bracket input by an input device and positional data of starting and ending points of the bracket located in the document so as to properly lay out the bracket around the bracketed text in the document. (Abstract, *Nakayama et al.*).

Obviousness and Analysis of Claimed Differences

2. **Claims 1, 3-5, 8-11, 13-15, and 17-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* (U.S. Pat. No. 6,891,551 B2).

With respect to independent **claim 1**, *Keely et al.* teach a method for facilitating modification of the extent of a selected block of information in a displayed presentation for further processing of said block (resizing of a selection, col. 2 line 51), said method comprising: receiving a first input from a user for defining a first endpoint of said selected block of information (e.g., clicking with a mouse, col. 5, lines 51-56); displaying a first endpoint marker at said first endpoint (e.g., selection handle 602a, col. 9, lines 5-9; *See also* Figs. 6A, 6B, and 6C); receiving a second input from said user for defining a second endpoint of said selected block of information (e.g., dragging with a mouse, col. 5, lines 51-56); displaying a second endpoint marker at said second endpoint, said selected block of information being defined by said first and second endpoint markers (e.g., selection handle 602b, col. 9, lines 5-9; *See also* Figs. 6A, 6B, 6C); and enabling said user to move either said first or second endpoint markers in order to correspondingly modify said extent of said selected block of information (selection area resizes itself as the user moves the selection handles, col. 9, lines 30-35).

Keely et al. do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers. However, *Keely et al.* does disclose that the body connecting the semi-transparent markers, that extends completely over and covers all selected text, is semi-transparent.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers because *Keely et al.* suggests it is desirable to have a semi-transparent selection tool that permits the underlying text to be viewable through the tool. *Keely et al.*, state, “The body 301 may alternatively be of a predefined color, and may be translucent or transparent to allow reading of selected/highlighted text. (col. 5, lines 30-42)(emphasis added). This would be especially obvious to one of ordinary skill in the art at the time the invention was made because *Keely et al.* further teach, ”Selection body 301 represents the selected portions of data...” (col. 5, lines 30-42). These teachings further combined with the suggestion that it, “...may be advantageous for providing real-time feedback to the user regarding the selected data. If, after resizing the selection area 601, the user wishes to further resize the area, the user can simply drag once again on a selection handle.” (col. 9, lines 30-40) would have motivated one of ordinary skill in the art at the time the invention was made, to have also made the endpoint markers semi-transparent, so that they are overlaying displayed content to enable a semi-transparent view of the said displayed content.

With respect to dependent **claim 3**, *Keely et al.* further teach the limitations of claim 1 wherein said first endpoint marker (handle 302a, Fig. 3) is visibly

different from said second endpoint marker (handle 302**b**, Fig. 3). As shown in Fig. 3 below, handle 302a points to the left, whereas handle 302b points to the right.

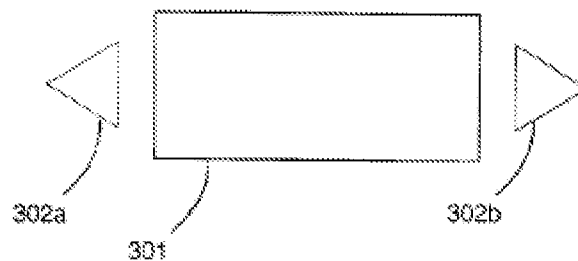


FIG. 3

Fig. 3 of *Keely et al.*

Keely et al. do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers as a result of the suggestions and motivations in *Keely et al.*, addressed in the rejection of claim 1.

With respect to dependent **claims 4 and 5**, *Keely et al.* further teach the limitations of claim 3 wherein the first endpoint marker is visibly designed to indicate a beginning of said selected block of information (“upstream” handle, col. 6,

lines 44-46); and said second endpoint marker is visibly designed to indicate an end of said selected block of information (“downstream” handle, col. 6, lines 44-46).

Keely et al. do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers as a result of the suggestions and motivations in *Keely et al.*, addressed in the rejection of claim 1.

With respect to dependent **claim 8**, *Keely et al.* further teach the limitations of claim 1 wherein enabling comprises responding to a user's movement of a mouse device (e.g., dragging with a mouse, col. 5, lines 51-56) to enable a corresponding movement of a displayed cursor to a selected one of said first or second endpoint markers (handle being moved, col. 5, line 49) said method further being operable in response to an actuation of a switch associated with said mouse device (clicking, col. 5, lines 53) in combination with a movement of said mouse device to move said selected one of said first or second endpoint markers in response to a movement of said mouse device (Movement of one or more selection handles 302 may be accomplished in many ways, such as clicking and dragging with a mouse” col. 5,

lines 51-56) to a new location thereby changing the extent of the selected block of information (“For selecting text, the dragging of a selection handle 302 may increase or decrease portions of the current selection body 301...” col. 5, lines 46-51).

Keely et al. do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers as a result of the suggestions and motivations in *Keely et al.*, addressed in the rejection of claim 1.

With respect to dependent **claims 9 and 10**, *Keely et al.* further teach the limitations of claim 8 wherein the selected block of information is shortened (...dragging of a selection handle 302 may...decrease portions of the current selection body 301...” col. 5, lines 46-51) or extended (...dragging of a selection handle 302 may increase...portions of the current selection body 301...” col. 5, lines 46-51) in response to movement of the one of the first or second endpoint markers.

Keely et al. do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said

one of said endpoint markers. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers as a result of the suggestions and motivations in *Keely et al.*, addressed in the rejection of claim 1.

With respect to dependent **claims 11, 13-15, and 17-20**, the only differences between these claims are that they are directed toward a storage medium defined by identical processes recited in claims 1, 3-5, and 7-10, respectively. Accordingly, these claims are rejected for the same reasons as set forth above.

With respect to independent **claim 21**, *Keely et al.* teach a system for processing a selected block of information in a displayed presentation, said system comprising: a system bus (“system bus 130,” col. 3, lines 22-23); a CPU device connected to said system bus (“processing unit 110,” col. 3, line 20); an input device connected to said system bus, said input device being arranged to enable user input to said system (input “keyboard,” col. 3, line 58); a display device connected to said system bus (display “monitor 107,” col. 3, line 67); and memory means connected to said system bus (“memory 120,” col. 3, line 26), said memory means containing code executable (“program modules,” col. 3, line 55) by said CPU device for receiving a first user input from a user for defining a first endpoint of a selected block of information (e.g., clicking with a mouse, col. 5, lines 51-56) and displaying a first

endpoint marker at said first endpoint (e.g., selection handle 602a, col. 9, lines 5-9; *See also* Figs. 6A, 6B, 6C), said system being further operable for receiving a second input from said user (e.g., dragging with a mouse, col. 5, lines 51-56) for defining a second endpoint of said selected block of information and displaying a second endpoint marker at said second endpoint (e.g., selection handle 602b, col. 9, lines 5-9; *See also* Figs. 6A, 6B, 6C), said selected block of information being defined by said first and second endpoint markers, said system being further operable for enabling said user to move either said first or second endpoint markers by using said input device in order to correspondingly modify said extent of said selected block of information (selection area resizes itself as the user moves the selection handles, col. 9, lines 30-35).

Keely et al. do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers as a result of the suggestions and motivations in *Keely et al.*, addressed in the rejection of claim 1.

3. **Claims 2 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* in view of *Carroll et al.* (US PG PUB 2003/0103082 A1).

With respect to dependent **claim 2**, *Keely et al.* teach the limitations as set forth in claim 1, above. *Keely et al.* do not expressly disclose at least one of the first and second endpoint markers displayed as a rectangular block and do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers.

However, *Carroll et al.* is cited for teaching at least one of the first and second endpoint markers displayed as a rectangular block ("cursor 104," para. [0025]; *See also* Figs. 1, and 3-6).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the "rectangular block" disclosed in *Carroll et al.* to display the endpoint markers disclosed in *Keely et al.* because *Carroll et al.*: (1) is directed to the same problem of the initiation and termination of select functions ("The initiation and termination of the select function can be accomplished by a number of techniques, including keystroke input and mouse input," para. [0004]); (2) is in the same field of endeavor of "[selecting] regions in an electronic text to edit the selected region on a continuous basis, without destroying the original highlighting and forcing the user to re-bracket the entire section." Abstract); and (3)

Keely et al. suggests the desirability of using a “rectangular block” (“cursor 104,” para. [0025]; *See also* Figs. 1, and 3-6) for the advantage of allowing “...a user to select text by moving a cursor from left to right and top to bottom [so that] the whole region of text desired to be highlighted does not have to be rebuilt every time a change is made.” (Abstract). It would have been further obvious to one of ordinary skill in the art, at the time the invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers as a result of the suggestions and motivations in *Keely et al.*, addressed in the rejection of claim 1.

With respect to dependent **claim 12**, the only difference between this claim and claim 2 is that it is directed toward a storage medium defined by the identical processes recited in claim 2. Accordingly, this claim is rejected for the same reasons as set forth in the rejection of claim 2, above.

4. **Claims 6 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keely et al.* in view of *Nakayama et al.* (US 5,737,618 A).

With respect to dependent **claim 6**, *Keely et al.* teach the limitations as set forth in claim 1, above. *Keely et al.* do not expressly disclose at least one of the first and second endpoint markers displayed as a bracket symbol and do not expressly disclose at least one of said endpoint markers being displayed as a semi-transparent

marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers.

However, *Nakayama et al.* is cited for teaching at least one of the first and second endpoint markers displayed as a bracket symbol ("a bracket position specifier 6 for specifying positions of starting and ending points between which a bracket specified by the data stored in the bracket specification storage 5 is to be located...", col. 8, lines 25-40).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the "bracket" disclosed in *Nakayama et al.* to display the endpoint markers disclosed in *Keely et al.* because *Nakayama et al.*: (1) is directed to the same problem of the initiation and termination of select functions in document processing systems such as word processors ("document processing systems such as word processors, personal computers, electronic diaries that are capable of editing documents," col. 1, lines 5-18); (2) is in the same field of endeavor of "displaying brackets extending across plural lines" (col. 1, lines 5-18); and (3) *Nakayama et al.* explicitly teaches the advantage: "to provide a document processing system which can determine a symbol input position based on the arrangement of document data when a symbol such as bracket symbol or graphic symbol extending across plural lines or columns is input, thereby facilitating the operation of designating the symbol input position." (col. 7, lines 50-59). It would have been further obvious to one of ordinary skill in the art, at the time the

invention was made, to have used the a semi-transparent marker overlaying displayed content to enable a semi-transparent view of said displayed content as viewed through said one of said endpoint markers as a result of the suggestions and motivations in *Keely et al.*, addressed in the rejection of claim 1.

With respect to dependent **claim 16**, the only difference between this claim and claim 6 is that it is directed toward a storage medium defined by the identical processes recited in claim 6. Accordingly, this claim is rejected for the same reasons as set forth in the rejection of claim 6, above.

(10) Response to Argument

I. Appellants' arguments (APPEAL BRIEF, p. 10 of 21) stress:

Keely does not even recognize the problem of markers blocking a view of underlying content.

The Examiner respectfully disagrees with Appellant's position. Initially, *Keely et al.* recognize that the body between the markers of a selection tool used to indicate which text is selected be "...translucent or transparent to allow reading of selected/highlighted text." (col. 5, lines 30-42). With this purpose in mind, *Keely et al.* contemplate using translucency or transparency with their tool for the same purpose of the Appellants – that is, to view underlying content. Equally important, *Keely et al.* teach that, "The tool may include body 301 and one or more selection handles 302a, b." (col. 5, lines 22-27). This teaching, *inter alia*, provides a factual basis to support a finding that the problem of obscuring the underlying text with a text selection tool was recognized by *Keely et al.* Moreover, *Keely et al.*'s

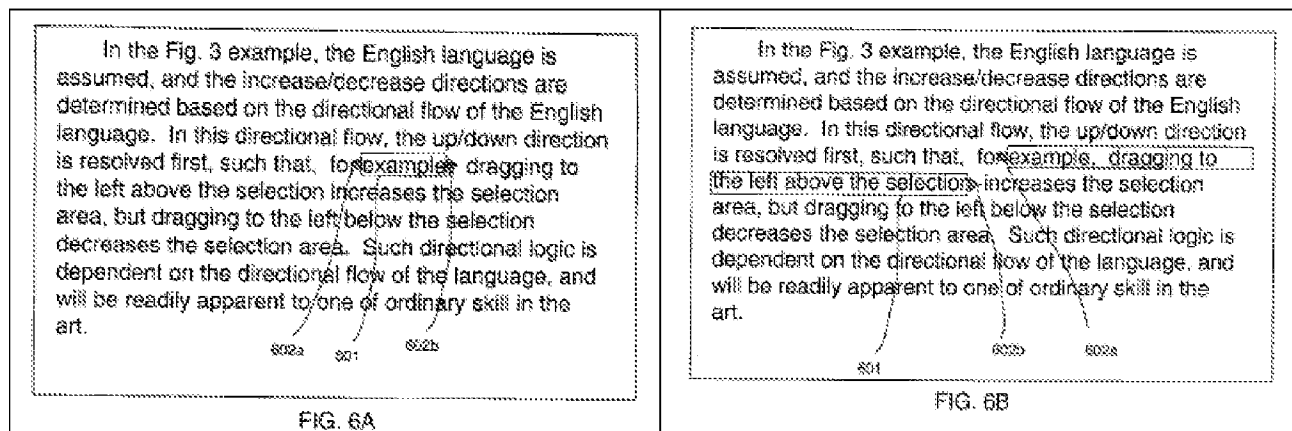
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contemplated solution to obscuring underlying text with a text selection tool was to employ the use of translucency or transparency.

II. Appellants' arguments (APPEAL BRIEF, p. 10 of 21) emphasize:

Keely discloses solid, non-transparent endpoint markers at the endpoints of a rectangular block enclosing selected text. Further, Keely clearly shows in his drawings (see Figures 6A and 6B) endpoint markers 602a and 602b which are solid and obstruct a view of the text underneath the markers. Still further, there is no mention in the entire context of the Keely reference that the end markers even could be transparent to enable the user to see document content which may be beneath the markers.

The Examiner respectfully disagrees with Appellant's contention. Appellant rely on figures 6A and 6B, both of which allegedly show endpoint markers 602a and 602b to be solid. In both of figures 6A and 6B, the tool is shown with darkened drag endpoint markers 602a and 602b:

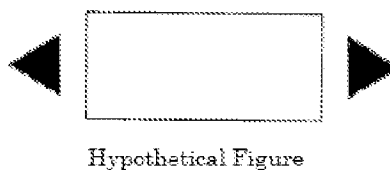


As an initial matter, Appellant's conclusion that markers 602a and 602b are solid is unsupported by any evidence of record. The markers in Figures 6A, 6B and 6C, even although depicted with shading, do not clearly convey they are solid. At the same time, any loss in quality by the reproduction of *Keely et al.*'s drawings

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cannot be relied on beyond what they reasonably convey to one of ordinary skill in the art. As discussed below, if figures 6A and 6B teach solid markers then it would have made sense that figure 3 clearly teaches³ transparent/translucent markers.

Assuming *arguendo*, that *Keely et al.*, by figures 6A and 6B above, disclosed (1) endpoint markers 602a and 602b to be solid and (2) body 601 to be *translucent or transparent*. If that were the case, it would then mean that figure 3 of *Keely et al.* should have looked like this:



However, figure 3 does not. Instead, *Keely et al.* have illustrated endpoint markers 302a and 302b to be translucent/transparent (just like body 301), clearly illustrated here:

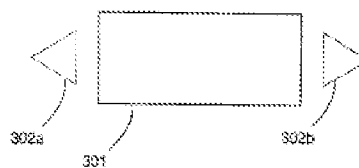


FIG. 3

One of ordinary skill in the art at the time of Appellant's invention⁴ would have recognized endpoint markers 302a and 302b to be translucent or transparent

³ In addition to figures 7A, 7B, 8A, 8B, 8C.

⁴ Appellant admits, on the record (APPEAL BRIEF, p. 11 of 21) that Keely was "[a] man of proven inventive ability, well beyond ordinary skill in the art." However, as discussed, *infra*, the Examiner takes

just like their body 301, particularly in view of the written description most concerned with figure 3 that discloses making body 301 "translucent or transparent...to allow reading of selected/highlighted text." (col. 5, lines 30-42).

Accordingly, it is respectfully submitted that if Appellant's logic is correct (i.e., that one of ordinary skill in the art would recognize that *Keely et al.* actually depicted solid endpoint markers in their drawings by shading) then it logically follows that where the endpoint markers are not shaded, they are as translucent or transparent as the other elements like which they are depicted.

III. Appellants' arguments (APPEAL BRIEF, p. 11 of 21) emphasize:

[a]pparently it was not obvious to even Keely, a man of proven inventive ability, well beyond ordinary skill in the art, to use semi-transparent endpoint markers even though the Examiner asserts that it would have been obvious to one of only ordinary skill in the art to have used a semi-transparent marker.

The Examiner respectfully disagrees with Appellant's position. Appellants have failed to articulate any facts which support a finding that *Keely et. al.* has demonstrated skill, "[w]ell beyond ordinary skill in the art." After considering the type of solutions to problems encountered in the art; rapidity with which innovations were being made; and the sophistication of the technology, the Examiner is of the position that at the time of Appellant's invention, the skill in this art was very high, as demonstrated by the solutions proposed by the references of record. Therefore, contrary to Appellants' factually unsupported assertion, *Keely et*

the position that the skill in this art was very high at the time of Appellants invention. Contrary to

al. appear to only demonstrate ordinary skill in an art, in which the level of ordinary level of skill was very high.

V. Appellants' arguments (APPEAL BRIEF, pp. 11-12 of 21) emphasize:

[t]he Examiner asserts that it would have been obvious to one of only ordinary skill in the art to have used a semi-transparent marker. There is no basis for such an assertion and it is submitted that the only applied reference Keely does not recognize the problem of blocking end-point markers much less suggest or provide a solution.

The Examiner respectfully disagrees with Appellants' arguments. In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007), the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *Id.*, and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would

improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

As an initial matter, there is factual evidence that the prior art (i.e., *Keely et al.*) taught using text selection tools with selection handles (i.e.; “upstream” handle, col. 6, lines 44-46; see also “downstream” handle, col. 6, lines 44-46). Second, there is factual evidence demonstrating that the prior art was possessed of a known technique to solve the problem of allowing the reading of text underneath the text selection tool, namely the use of translucency and transparency in text selection tools (by making portions of it “...translucent or transparent to allow reading of selected/highlighted text.,” col. 5, lines 30-42). Third, the evidence of record reasonably suggests that one of ordinary skill in the art would have recognized that applying translucency or transparency to an overlaying text selection tool would have yielded the predictable result of allowing the reading of the underlying text, resulting in an improved system thereby.

IV. Appellants' arguments (APPEAL BRIEF, pp. 12-13) explain:

[I]t is further noted that even though Keely is working with the problem staring him in the face, he does not recognize the problem or even suggest a solution. How can it then be alleged that it is obvious to one of ordinary skill in the art? Thus, it is submitted that by definition, the “see-through” end-point marker could not have been obvious to one of ordinary skill in the art since it was not even apparent to Keely, one

of proven inventive ability, who was working directly with a blocking function of a word processing application.

The Examiner respectfully disagrees with Appellants' argument. When it came time for *Keely et al.* to solve the problem of being able to read the text through the text selection tool, *Keely et al.* elucidate making that part of the tool "...translucent or transparent to allow reading of selected/highlighted text.;" (col. 5, lines 30-42). In addition to the reasons already discussed, the use of translucency or transparency with text selection tools yielded the predictable result of allowing one to read the underlying selected/highlighted text. The use of this technique for the *endpoint markers* was not beyond the skill of a person of ordinary skill in the art at the time of Appellant's invention, particularly in view of fact that *Keely et al.* further suggest this solution by illustrating the *end-point* marker be *see through* as previously discussed in figure 3.

V. Appellants' arguments (APPEAL BRIEF, pp. 12-13) explain:

(It is noted that claims 16 and 18 are dependent claims and not independent claims as asserted by the Examiner in paragraph #2 on page 2 of the Final Office Action mailed 7/27/2007).

Appellants have correctly pointed out this typographical error but failed to acknowledge that the substantive analysis in the Final Action mailed 7/27/2007 clearly treated claims 16 and 18 as dependent. More specifically, the relevant section addressing claim 16 reads: "As to dependent, **claim 16**,..." (p. 14)(emphasis added); and for claim 18 it reads: "As to dependent **claims 11, 13-15, and 17-20**,..." (p. 11) (emphasis added).

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- VI. Appellants argue for the patentability of claims 2, 6, 12, and 16 without considering any of the secondary references used to establish obviousness under 35 U.S.C. § 103(a).

Appellants have made no separate arguments with respect to the secondary references as applied to claims 2, 6, 12, and 16.

It is respectfully submitted that the remainder of Appellants arguments have been substantively responded to by the foregoing response.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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